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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,950	10/27/2003	Kentaro Fujino	244405US0X	2139
22850 7590 01/11/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KNABLE, GEOFFREY L	
			ART UNIT 1733	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/692,950

Applicant(s)

FUJINO ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10-17-06; 10-25-06
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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1. Claim 11 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the election requirement in the reply filed on 4-24-2006.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 depends from a canceled claim.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3-8 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1-14, 30, 33, 42 and 44 of copending Application No. 10/477,710. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the

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claims of the conflicting application do not describe "an innerliner for pneumatic tires", it is not seen that this clearly defines anything other than a barrier film material that is capable of acting as a tire innerliner, it being considered that the claims to a film material and especially a barrier material (esp. claim 30 as well as claim 8) in the conflicting application are such as to render the presently claimed material obvious. Note further, that the modified polymer is formed in substantially the identical manner to that claimed (e.g. claims 12-13 of the conflicting patent) except that the ethylene content in the conflicting application claims is claimed as 5-55 mol% which is broader than the claimed 25-50 mol%. It is however considered to have been obvious to utilize any ethylene content within the range values in the reference absent some showing of unexpected or unobvious results, this rendering obvious selection of an ethylene film that would meet the claimed requirements for an "innerliner". The presently claimed innerliner, including the use of another elastomer layer (note claim 44 of the conflicting application) comparable to the claimed "auxiliary layer", is therefore considered to have been obvious given the relevant claims of this application. The particular thickness chosen for the various layers would have been readily and routinely selected, the claimed wide ranges not being considered to represent unobvious adaptations of the claimed disclosures.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 9, 10, and 15-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1-14, 30,

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33, 42 and 44 of copending Application No. 10/477,710 in view of Lin et al. (US 5,292,590).

The conflicting claims, as noted above, are considered to render obvious a barrier material that is considered to render obvious a material as claimed. Use as a tire innerliner material is not however suggested. Lin et al., as set forth in the last office action, discloses an innerliner and tire with this innerliner formed from an ethylene vinyl alcohol copolymer that preferably contains less than 50% ethylene content and is more than 90% saponified (esp. col. 2, lines 53-63). Modification with an epoxy compound as claimed is not however taught. It is considered however that given the disclosure of the conflicting claims of the conflicting application, taken in view of the known suitable and effective use of EVOH material as tire innerliners, it would have been obvious to apply the improved modified EVOH barrier material of the conflicting application to innerliners in tires and thus a tire having an innerliner including the claimed material is considered an obvious adaptation of the claimed barrier material of the conflicting application. A tire as claimed is therefore considered to have been obvious. Further, with use in a tire innerliner, use of a low permeability elastomer such as butyl for the auxiliary layer as required by claims 9 and 10 would have been obvious for the same reasons set forth in the last office action.

This is a provisional obviousness-type double patenting rejection.

6. Claim 18 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1-14, 30, 33, 42 and 44 of copending Application No. 10/477,710 in view of Lin et al. (US 5,292,590) as applied

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above and further in view of at least one of [Liu et al. (US 5,280,817) and Weston et al. (US 5,879,488)].

These secondary references are substantively applied for the same reasons as set forth in the last office action.

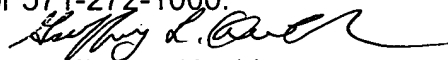
This is a provisional obviousness-type double patenting rejection.

7. Applicant's arguments and accompanying translation of the priority document, filed 10-16-2006, with respect to the rejection(s) of the claim(s) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, note new obviousness double patenting rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
January 6, 2007